

App. No.: 09/863,882

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REMARKS

Claims 1-6, 9, and 10 are pending in the present application. Claims 1, 3, 4, 6, and 10 have been amended to correct typographic errors and/or to further clarify the subject matter recited therein. No new matter is added by the amendments, which are supported throughout the specification and figures. In particular, the amendments are supported at least in the specification at page 35, lines 18-19. In view of the amendments and the following remarks, favorable reconsideration of this case is respectfully requested.

The Examiner has not acknowledged in the instant application the claim of priority, which was made on May 23, 2001, and receipt of the priority documents, which were filed on October 20, 2001. Applicants hereby respectfully request such acknowledgement in the next communication from the United States Patent and Trademark Office.

Claims 1, 3, 4, and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldhaber (U.S. 5,855,008) in view of Gardenswartz (U.S. 6,055,573). Applicants respectfully traverse.

Claim 1 relates to a server apparatus for applying one or more incentive points by which a service can be received in response to an amount of said points to be used in a Web site. The server apparatus of claim 1 includes, among other things, display point determining means for determining a point number to be displayed on said advertisement within said applicable point number in accordance with a predetermined rule that includes *decreasing said point number as a total number of points, accumulated by the person for said advertisement, increases*. In amended claim 1, *the larger the total number of points accumulated by the person becomes, the smaller the point number to be displayed becomes stepwise*.

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The Examiner admits that Goldhaber fails to teach that said predetermined rule includes decreasing said point number as a total number of points, accumulated by the person for said advertisement increases (Office Action; page 4, line 3 et. seq.). The Examiner asserts that Gardenswartz discloses a system that targets advertisements to consumers as a form of a value contract, in which a consumer is offered a reward (i.e. points) for interacting with an advertisement (citing Gardenswartz; col. 20, lines 45-50) and where said reward (i.e. points) is decreased based upon previous interaction of said consumer with said advertisement (citing Gardenswartz; col. 17, lines 20-45; and col. 18, lines 1-5).

However, the cited sections apparently relate only to targeted, interactive messages (Gardenswartz; col. 20, lines 45-50), and varied rewards offered for different exchange contracts (Gardenswartz; col. 17, lines 20-45). The cited sections apparently discuss decreasing and increasing rewards following a user's acceptance or refusal of an offer in order to modify the behavior by, for instance, improving the terms of an offer in response to a failure to accept by the consumer. The cited sections do not disclose or suggest "display point determining means for determining a point number to be displayed on said advertisement within said applicable point number in accordance with a predetermined rule that includes *decreasing said point number as a total number of points, accumulated by the person for said advertisement, increases*", as recited in claim 1. There is no discussion in the cited sections of Gardenswartz relating to a total number of points accumulated by the person, nor is there any discussion of decreasing a point number based on a trend in accumulated points. Therefore, none of the references disclose or suggest this feature, and therefore the combination of the references does not render the claim obvious.

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Additionally, and in the interest of expediting prosecution, Applicants herein amend the claims to clarify the features of the present invention. In particular, claim 1 has been amended to include the feature that "the larger the total number of points accumulated by the person becomes, the smaller the point number to be displayed becomes stepwise". It is respectfully submitted that none of the prior art references disclose or suggest this feature. In particular, and as discussed above, the Examiner admits that Goldhaber fails to teach that said predetermined rule includes decreasing said point number as a total number of points, accumulated by the person for said advertisement increases, and therefore Applicants submit that Goldhaber also fails to disclose or suggest a stepwise relationship between an increasing customer's point total and an advertisement's displayed points. Similarly, Gardenswartz's apparent disclosure of decreasing *and increasing* rewards following a user's acceptance or refusal of an offer does not disclose or suggest the stepwise relationship claimed in each of the independent claims.

Additionally, the Examiner asserts that the motivation to combine the references is to encourage a user to continue to engage in undesirable behavior and/or to change undesirable behavior. The Examiner asserts that an advertiser using the Goldhaber's system would be motivated to decrease the amount of compensation pay to users (i.e. view-op) that have already interacted with an advertiser's ad (Office Action; page 4, bottom). However, this asserted motivation is contrary to the teaching in Goldhaber, which is directed at *maintaining* the attention of a viewer. The combination of the references therefore results in an inoperative combination, and certainly does not result in a system according to the present invention, in which points are decreased for subsequent viewings by a user. Therefore for at least this additional reason the rejection should be withdrawn.

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Independent claims 3, 4, and 6 include features similar to those discussed above, and therefore these claims are allowable for at least the same reasons as claim 1 is allowable.

Claims 2, 5, 9, and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldhaber (U.S. 5,855,008) in view of Gardenswartz (U.S. 6,055,573) and further in view of Ikeda (U.S. 5,937,391). Applicants respectfully traverse.

Ikeda does not cure the deficiency in Goldhaber and Gardenswartz. Ikeda does not teach or disclose the above feature of the present invention because Ikeda is silent on advertisements. Therefore, since claims 2, 5, and 9 depend from claims 1, 4, and 6, respectively, these claims are allowable for at least the same reasons as their respective base claims are allowable.

Independent claim 10 includes features not disclosed in any of the prior art references. Claim 10 relates to a server that includes, *inter alia*, an applied point manager for storing an identifier for a user who selects the advertisement *and a stored point total associated with the user, the applied point manager adding the point number included in the advertisement selected by the user to the stored point total*, the applied point manager applying the stored point total as a discount between the user and a retailer. The server of claim 10 also includes a network arrangement adapted to communicate with a user and to allocate a cost of the discount from the retailer to an advertiser, the advertiser being associated with the advertisement. In the server of claim 10, *the larger the stored point total accumulated by the user becomes, the smaller the point number to be displayed becomes stepwise*. Applicants respectfully submit that none of the references disclose or suggest these features, and therefore for at least this reason claim 10 is allowable.

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CONCLUSION

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



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